•••REMARKS•••

The Official Action has been thoroughly studied. Accordingly, the changes presented herein for the application, considered together with the following remarks, are believed to be sufficient to place the application into condition for allowance.

By the present amendment claim 1 has been amended to more clearly describe applicant's invention in accordance with the requirements of 35 U.S.C. §112.

In addition, claim 2 has been changed to recite that the secondary extension step and the secondary contraction step occur after step (f). Support for this change can be found in applicant's specification in the paragraph bridging pages 8 and 9.

Finally by the present amendment, claim 3 has been changed to recite that the thermoplastic synthetic fibers are initially engaged and subsequently disengaged in the step (e). This change more clearly describes applicant's claimed invention.

Claims 1-6 are pending in this application.

Claim 2 stands rejected under 35 U.S.C. §112, first paragraph. Under this rejection the Examiner has correctly noted that the specification discloses the secondary extension and secondary contraction are conducted after step (f).

Accordingly, in response to the rejection of claim 2, applicant has amended claim 2 to recite that the secondary extension step and the secondary contraction step occur after step (f).

Claim 3 stands rejected under 35 U.S.C. §112, second paragraph. Under this rejection the Examiner states that it is unclear what is meant by the recitation of "the thermoplastic synthetic fibers are engaged with each other by at least one of mechanical entanglement and fusion bonding" and "are disengaged so that they are individualized."

In response to this rejection, claim 3 has been amended herein to recite that the thermoplastic synthetic fibers are initially engaged and subsequently disengaged in the step (e).

This change is believed to address and overcome the outstanding rejection of claim 3.

Claims 1-6 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,683,787 to Boich et al. in view of U.S. Patent No. 2,867,560 to Strawinski.

For the reasons set forth below, it is submitted that each of the pending claims are allowable over the prior art of record and therefore, the outstanding rejection of the claims should properly be withdrawn.

Favorable reconsideration of the following remarks by the Examiner is respectfully requested.

The Examiner has relied upon Boich et al. as disclosing a method of producing a multi-layered elastic sheet that includes the steps of continuously feeding a layer of a non-elastic fiber or filament layer and an elastic layer of homogeneous film or sheet, positioning the non-elastic layer on the elastic film or sheet and joining the two together at mutually spaced-apart connection sites.

The Examiner concedes that Boich et al. does not disclose the steps of extending the elastic film in one direction and allowing the elastic film to retract.

"However," the Examiner states, "extending and retracting an elastic film prior to bonding to additional webs are well known and conventional to one in the art as shown for example by Strawinski.

The Examiner states that Strawinski teaches the stretching of an elastic film prior to bonding it to a paper fiber layer, and that the elastic film is stretched to a predetermined extent in two directions, and that after the film has been stretched to ten or more times the original area, the film is allowed to shrink or relax to about five to ten percent of the fully stretched area, after which the exterior webs are brought into contact with the film to be bonded.

In combining the teachings of Boich et al. and Strawinski the Examiner takes the position that:

> It would have been obvious....to pre-stretch an elastic film and allow the film to retract or relax to reduce internal tension and the tendency to pin hole during subsequent heat treatment prior to bonding to additional external webs as taught Strawinski et al.

Applicant respectfully submits that, rather than being obvious, it would be improper to modify Boich et al. to pre-stretch the elastic film and allow it to retract or relax prior to bonding the elastic and non-elastic films together.

In this regard, applicant notes that an object of Boich et al. is to create "a voluminous textile surface...with a minimal use of material" as stated at column 2, lines 24-25.

This goal of Boich et al. is achieved by bonding the non-elastic fiber or filament layer 10 to the elastomeric layer 12 in a non-stretched state as depicted in Fig. 1, then stretching the bonded laminate as depicted in Fig. 2, and subsequently, untensioning the laminate as depicted in Fig. 3.

As a result of the process taught and required by Boich et al., the non-elastic fiber of filament layer 10 stretches but does not return to its non-stretched state. Instead, the non-elastic fiber or filament layer 10 "forms folds between the spaced-apart connection points 14 in the manner of a concertina" as taught at column 5, lines 13-15.

It is the formation of the folds in the non-elastic fiber of filament layer 10 that achieves Boich et al.'s goal of creating "a voluminous textile surface...with a minimal use of material"

If the modification which the Examiner purports to be obvious were applied to Boich et al., that is if the elastic film were pre-stretch and allowed to retract or relax prior to bonding the non-elastic fiber or filament layer film thereto, the purpose, object, and goal of Boich et al. would be lost or destroyed, because no folds would be formed in the non-elastic fiber or filament layer.

As held by the Board of Patent Appeals and Interferences in *Ex parte Hartmann*:

> References cannot properly be combined if effect would destroy invention on which one of reference patents is based. *Ex parte Hartmann*, 186 USPQ 366 (PTO Bd App 1974).

As held by the court of patent appeals in *In re Wesslau*:

> It is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *In re Wesslau*, 147 USPQ 391, at 393 (CCPA 1965)

It is improper to rely upon Boich et al. as teaching the use of a non-elastic film and an elastic film which are bonded intermittently together to the exclusion of the specific teaching by

Boich et al. of first bonding the films together and thereafter stretching the laminate and relaxing the same to produce folds in the non-elastic film.

The teachings of Strawinski which are relied upon by the Examiner do not overcome the impropriety of the modification of Boich et al.

For the reasons pointed out above, the teachings of Strawinski are not at all applicable to Boich et al.

Based upon the above distinctions between the prior art relied upon by the Examiner and the present invention, and the overall teachings of the prior art, properly considered as a whole, it is respectfully submitted that the Examiner cannot rely upon the prior art as required under 35 U.S.C. §103 to establish a *prima facie* case of obviousness of applicant's claimed invention.

It is, therefore, submitted that any reliance upon the prior art would be improper inasmuch as the references do not remotely anticipate, teach, suggest or render obvious the present invention.

It is submitted that the claims, as now amended, and the discussion contained herein clearly show that the claimed invention is novel and neither anticipated nor obvious over the teachings of the prior art and therefore, the outstanding rejection of the claims should hence be withdrawn.

Therefore, reconsideration and withdrawal of the outstanding rejection of the claims and an early allowance of the claims is believed to be in order.

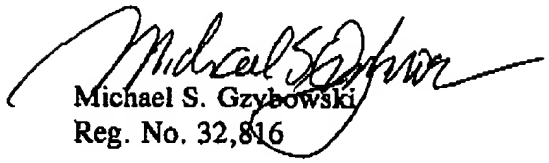
It is believed that the above represents a complete response to the Official Action and reconsideration is requested.

If upon consideration of the above, the Examiner should feel that there remain outstanding issues in the present application that could be resolved, the Examiner is invited to contact applicant's patent counsel at the telephone number given below to discuss such issues.

To the extent necessary, a petition for an extension of time under 37 CFR §1.136 is hereby made. Please charge the fees due in connection with the filing of this paper, including extension of

time fees, to Deposit Account No. 02-0385 and please credit any excess fees to such deposit account.

Respectfully submitted,



Michael S. Gzybowski
Reg. No. 32,816

BAKER & DANIELS
111 East Wayne Street
Suite 800
Fort Wayne, Indiana 46802
(219) 460-1661

Marked-up Copy of the Claims
as Amended on July 16, 2002

1. (Twice Amended) A process for manufacturing a composite sheet capable of elastic stretch and contract in one direction, said [manufacturing] process including the steps of:

(a) continuously feeding, in one direction, a first web capable of elastic stretch and contraction and having a top surface and a bottom surface;

(b) extending the first web in the one direction within a range that permits elastic stretch and contraction of the first web;

(c) allowing the extended first web to retract by an elastic contraction force of the web;

(d) continuously feeding at least one second web [in an intermittent manner] along the one direction;

(e) superimposing said at least one second web on at least one of said top surface and said bottom surface of the first web; and

(f) joining the first and second webs in an intermittent manner along the one direction.

2. (Twice Amended) The process of Claim 1 further including, subsequent to the step [(e)] (f) the following steps:

(i) a secondary extension step wherein the joined first and second webs are extended in the one direction within a range that permits elastic stretch and contraction of the first web; and

(ii) a secondary contraction step wherein the extended first and second webs are allowed to retract by action of an elastic contraction force of the first web.

3. (Twice Amended) The process of Claim 2, wherein the thermoplastic synthetic fibers in said at least one second web are initially engaged with each other by at least one of mechanical entanglement and fusion bonding and, subsequently in the step (e) the thermoplastic synthetic fiber are disengaged so that they are individualized.